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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,879	08/17/2000	Toshiyuki Shibuya	A243-1	5305
21254	7590	12/16/2005	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC			KISS, ERIC B	
8321 OLD COURTHOUSE ROAD			ART UNIT	
SUITE 200			PAPER NUMBER	
VIENNA, VA 22182-3817			2192	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,879

Applicant(s)

SHIBUYA, TOSHIYUKI

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10-18,20-28,30-32 and 34 is/are rejected.
- 7) ☒ Claim(s) 3,9,19 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 July 2005 has been entered. Claims 1-5 and 7-34 are pending.

Response to Amendment

2. The objection to claim 2 is withdrawn in view of Applicant's amendment.

Response to Arguments

3. Applicant's arguments filed 14 July 2005 have been fully considered but they are not fully persuasive.

Specifically, Applicant's argument that, "because Cowan explicitly contradicts the method described in the independent claims of the present invention, this reference cannot be modified to allege that the method of the present invention would thereby be rendered obvious," is not persuasive. It is noted that Cowan does not expressly teach away from the proposed combination by expressing either undesirability or impossibility of transferring only necessary files. Nor does Cowan describe a system in which adding the capability to discern necessary files would render the system inoperable.

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However, Applicant's argument regarding the use of the checksum in claims 3, 9, 19, 29, and 33 has been considered and is persuasive. Therefore, the rejections of these claims have been withdrawn.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 4, 5, 7, 8, 10-18, 20-28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,848,064 to Cowan and U.S. Patent No. 6,237,144 to Delo.

As per claims 1, 4, and 32, Cowan discloses a portable terminal device (mobile terminal) comprising a memory including a program storage area storing therein at least two programs (or a plurality of programs) grouped into at least two groups with respect to overall functions of said terminal device, as supported by said programs, said at least two groups including categorization whether a program is necessary for a change of an overall function to be executed by said terminal device, said program storage area thereby including a to-be-used program, and optionally, a to-be-removed program (see, for example, col. 1, lines 48-57; col. 7, lines 13-31; and col. 12, lines 49-59) and a program executing area (see, for example, col. 7, lines 13-19). Cowan further discloses the memory containing a management table which stores first data about whether each of said programs is used or not (see column 7, lines 37-50; and column 12, lines 49-52), and removes a non-used program from said memory (see, for example, column 12, lines 49-55). For example, when an upgrade is performed in fail-safe mode, the files belonging to the new version are downloaded. During this operation, both the new files (to-be-used) and the old

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files (to-be-deleted) are stored in the memory. Upon successful completion of the download, the old files are discarded (deleted). Cowan fails to expressly disclose the data about whether the programs are used or not being based upon a selection from a terminal device user to change an overall function of the device. However, Delo teaches a memory management table (a relational database) that stores data designating said to-be-used program and said to-be-removed, wherein said data causes said to-be-removed program to be removed from said program executing area (see, for example, col. 5, lines 15-31). Delo further teaches such data resulting from a user selection to change an overall function of a device (see, for example, col. 5, lines 15-31). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to modify the device and method of Cowan to include a management table responsive to user selection as taught by Delo. One would be motivated to do so to let a terminal device user have greater control over how software is installed/modified.

As per claim 2, Cowan further discloses said to-be-used program being added to said program storage area from a program-transferring device and transferred to said program executing area, in accordance with said data (see, for example, col. 7, lines 13-36 and column 13, lines 15-46). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 5 and 14, Cowan discloses a portable terminal device (mobile terminal) comprising a program storage area storing at least one to-be-used program transferred from a base station (see, for example, Fig. 1; and col. 11, line 66, through col. 2, line 19), a program executing area that stores a main program and an at least one application program, each said at least one application program being necessary for executing device functions of said terminal device and said main program controlling said at least one application program to provide an

overall terminal device function selected by a terminal device user (see column 7, lines 13-36) and a memory management table that stores data relative to which application programs are necessary for said overall terminal device functions and which application programs are unnecessary (see, for example, column 8, lines 19-32; and column 12, lines 15-28); and a signal receiving/transmitting circuit and a central processing unit (see Fig. 2); wherein a change of overall terminal device functions is achieved by adding any of one or more application programs necessary for a selected new overall terminal device function and a new main program for executing said selected new overall terminal device function, using the added one or more application programs, along with any application programs already stored in said terminal device for a previously-selected function that are also necessary for said selected new overall terminal device function. Cowan fails to expressly disclose the data about whether the programs are used or not being based upon a selection from a terminal device user to change an overall function of the device. However, Delo teaches a memory management table (a relational database) that stores data designating said to-be-used program and said to-be-removed, wherein said data causes said to-be-removed program to be removed from said program executing area (see, for example, col. 5, lines 15-31). Delo further teaches such data resulting from a user selection to change an overall function of a device (see, for example, col. 5, lines 15-31). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to modify the device and method of Cowan to include a management table responsive to user selection as taught by Delo. One would be motivated to do so to let a terminal device user have greater control over how software is installed/modified.

As per claims 7 and 27 (see the rejection of parent claim 22 below), Cowan further discloses package definition files including a program ID of each program (file name), a flag indicating whether each program is used or not (a user selection); a packet number and final packet number transferred from the program-transferring device (see, for example, column 13, lines 54-65); an initial address (mobile terminal path and host path); and a program length (memory required; see Figs. 5a through 5d; column 11, lines 24-35; and column 14, line 62 through column 15, line 9). Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 8, Cowan further discloses the memory adding only a necessary program from a program-transferring device, in accordance with said data, wherein said necessary program comprises said to-be-used program (see column 13, lines 15-46). Therefore, for reasons stated above, such a claim also would have been obvious. Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 10-12, Cowan further discloses the memory comprising an EEPROM portion (see column 7, lines 15-19) and a RAM portion (see column 9, lines 12-15). Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 13, the connection of a power source to the RAM in Cowan is implied as files are transferred to and stored in the RAM (see column 9, lines 12-15). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 15 and 22, in addition to the disclosure and teachings applied above to claims 1 and 5, Cowan further discloses a base station and a program-transferring device (host; see Fig. 1). For reasons stated above, such a claim also would have been obvious.

As per claims 16, 21, 23, 28, and 31, see the disclosure applied above to claims 2 and 4. For reasons stated above, such claims also would have been obvious.

As per claim 26, Cowan further discloses storing data about whether the main program and application program is used or not (see, for example, column 8, lines 19-32; column 12, lines 15-28; and column 14, lines 50-61). Therefore, for reasons stated above, such a claim also would have been obvious.

As per claims 17, 18, 24, and 25, Cowan uses an IP address associated with each mobile terminal to encode transmissions (see, for example, column 8, lines 25-32). Therefore, for reasons stated above, such claims also would have been obvious.

As per claims 20 and 30, Cowan further discloses the program-transferring device comprising a memory storing a program, a encoding/transferring circuit, and a controller circuit (see Fig. 3). Therefore, for reasons stated above, such claims also would have been obvious.

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan in view of U.S. Patent No. 5,414,751 to Yamada.

As per claim 34, Cowan discloses storing first indicia of said existing and used programs in a table of a memory of said terminal device (see column 7, lines 37-50; and column 12, lines 49-52); requesting a change of programs by said terminal device, said change of programs including at least one of an added program to provide a necessary function to be used with one or more said existing and used programs to reconfigure an overall function of said terminal device (see column 7, lines 37-50; and column 12, lines 49-52); and storing said second indicia of said change of programs in said table (see column 7, lines 37-50; and column 12, lines 49-52).

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Cowan further discloses receiving said at least one to-be-added program and loading an added program into memory (see, for example, col. 12, lines 29-59); using (booting) an updated version of software while deleting (non booting) an unused, older, version of the software (see, for example, col. 12, lines 49-52). Cowan fails to expressly disclose copying existing and used programs from a program executing area to a program storage area of said terminal device prior to performing the upgrading. However, Yamada teaches copying existing and used programs from a second memory to a first memory of a terminal device and loading an added program into the first memory as part of a software upgrading process (see, for example, col. 4, lines 20-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Cowan to include such copying during upgrading as per the teachings of Yamada. One would be motivated to do so to increase the reliability of the upgrade process.

Allowable Subject Matter

7. Claim 33 is allowed.
8. Claims 3, 9, 19, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist: 571-272-2100.

EBK /EBK
December 9, 2005



TUAN DAM
SUPERVISORY PATENT EXAMINER